

REMARKS

The present response is intended to be fully responsive to the rejection raised by the Office Action and is believed to place the application in condition for allowance. Further, the Applicants do not acquiesce to any of the Office Action rejections not particularly addressed. Favorable reconsideration and allowance of the application is respectfully requested.

1. Allowed and Rejected Claims

The Applicants thank the Examiner for allowing claims 12-15, 38 and 39. The Applicants note, however, that the Examiner rejected (i) claims 1-11, 16-37 and 40-43 under 35 U.S.C. §112, first paragraph, and (ii) claim 16 under 35 U.S.C. §103(e) as being unpatentable over the combination of U.S. Patent No. 6,141,341, granted to Jones et al. ("Jones") and the Examiner's Official Notice.

2. Rejection Under 35 U.S.C. §112, first paragraph

The Examiner rejected claims 1-11, 16-37 and 40-43 under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. Specifically, the Examiner rejected independent claims 1, 16, 20, 25, 36 and 40 because the edge device/apparatus is not sufficiently described in the specification and accompanying drawings. With respect to this rejection, the Examiner poses the question "referring to figure 1, is the edge device the H.323 System 100, the Virtual Distributed Gatekeeper, or neither?"

With respect to a preferred embodiment shown in Figure 1, the edge device is neither the H.323 System 100 nor the Virtual Distributed Gatekeeper. Rather, the edge device and its associated functionality are embodied as an edge router.

Further, the Applicants submit that the claimed edge device and its associated functionality are not indefinite or ambiguous in any way, but rather, clearly defined in the specification. For

instance, claim 1, in its preamble, provides that the edge device is coupled in communication with the call-switching device, and the edge device has a first H.323 port. The method of claim 1 includes, in part, the functions of (i) transmitting from the edge device to the call-switching device a second admission request for the H.323 call, (ii) responsive to transmitting the second admission request, receiving from the call-switching device at the edge device an admission confirmation for the H.323 call, the admission confirmation indicating that the H.323 call can proceed, (iii) storing on the edge device a call state information, the call state information corresponding to a state of the H.323 call, and (iv) updating the call state information on the edge device after receiving the admission confirmation.

The support for these claimed elements may be found in the preferred embodiment of Figure 1 and pages 7-12 of the present specification. Specifically, the Applicants first refer the Examiner to the conspicuously labeled boxes ER 106, ER 107, ER 120 and ER 121 in Figure 1. Next, the Applicant refer the Examiner to page 7, which states that the ERs 106-107, and ERs 120-121 are edge routers, i.e., edge devices. See the present specification at page 7, lines 10-13. With respect to ERs 106-107 of the H.323 system 100, the specification further states:

"The H.323 packets flow into an edge router such as the ERs 106-107. The edge routers include the functionality of a standard H.323 gateway, providing IP ports for H.323 calls. Additionally, the ERs 106-107 provide a memory for storing call state information. ... Further, the ERs 106-107 may include a DOCSIS interface, support for a standard network address translation (NAT) protocol, and support for H.323 proxy services. ... The ER 106 communicates with the GC [gate controller] 104 on a transactional basis to receive responses to registration, admission, and status requests. Because the GC 104 is used on a transactional basis, no call state information need be stored in the GC 104. The GC 104 can access the BESs [back end servers] 105 for storing accounting and billing information received from the ERs 106-107. ... If the GC 104 fails, a call handled by one of the ERs 106-107 is not disrupted. This is because call state information is stored on the edge router handling the call." *Id.* at page 7, line 22 to page 8, line 11.

The present specification also states that "[t]he H.323 system 114 is similarly configured with the functionality of the virtual distributed gatekeeper 116 the GC 118, the BESs 117, and the ERs 120-121 being the same as their counterparts in the H.323 system 100." *Id.* at page 12, lines 1-3.

Furthermore, the present specification states that "all packets between the MTA [multimedia terminal adapter] 108 and MTA 122 pass through the edge routers to reach the other MTA." *Id.* at page 16, lines 3-5. As such, the edge routers rather than the gate controllers are the logical network nodes to store the call state information. "Because the gate controllers only need to respond in a transaction oriented fashion, any failure of a gate controller is non-critical and does not disrupt the call or the accounting for a call in progress." *Id.* at page 18, lines 6-8. "As each of the messages is relayed through the ERs 106 and 120, call state information is constantly updated as appropriate on the edge router." *Id.* at page 18, lines 9-10.

In addition to the above-quoted sections, the Applicants invite the Examiner to review the rest of the specification and drawings, which provides details of the structure and the functions carried out by the claimed edge device. In light of the foregoing, the Applicants respectfully submit that the present specification is fully enabled, and thereby allows one skilled in the art to make and use the claimed invention. Thus, the Applicants submit that claims 1-11, 16-37, and 40-43 are allowable.

3. Rejection under 35 U.S.C. § 103(a)

As noted, the Examiner rejected claim 16 U.S.C. §103(a) as being unpatentable over *Jones* in view of his Official Notice. In this rejection, the Examiner states that *Jones* teaches all of the combination of elements of claim 16 except for the element in which the call state information is stored in the memory of the edge device. To supply this element, the Examiner takes Official Notice that "given the system contains a memory, it would be obvious to store call state information (i.e., duration of call that can be computed from the on/off hook information) in the memory." The

Examiner then states that "this would improve the system since this provides a means for billing the customer."

A. Challenge of Official Notice

The Applicant respectfully challenges the taking of Official Notice. Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings **will not support** an obviousness rejection) (emphasis added).

The Applicants emphatically disagree with the contention that the record contains specific factual findings and concrete evidence to support that it is known "to store call state information [for an H.323 call] (i.e., duration of call that can be computed from the on/off hook information) in the memory" of the edge device. Upon review of the previous Office Action responses, which are incorporated herein by reference, and the cited art, nowhere has it been shown that call state information for an H.323 call is stored in memory of an edge device as claimed. In fact, as pointed out in each of the previous responses, the previously cited art actually taught away from the presently claimed invention. The Applicants invite the Examiner to review the prior responses and cited art. Thus, pursuant to M.P.E.P. § 2144.03, Applicant respectfully requests that a supporting reference be cited.

B. The Proposed Combination Does Not Teach All the Elements

According to M.P.E.P. § 2143, in order to establish the required *prima facie* case of obviousness of a claimed invention by applying a combination of references, the proposed

combination must teach or suggest all of the elements of the claimed invention. The Applicants respectfully submit that *Jones*, the Examiner's Official Notice and/or a combination thereof does not disclose claimed invention, despite the Examiners contention.

The Examiner states that the combination of *Jones* and the Examiner's Official notice teaches the element "an edge device having a first H.323 port and a memory, the memory containing call state information, the call state information including a call state for an H.323 call on the first H.323 port." To support this contention, the Examiner states that the claimed edge device is the network-premises gateway 10 shown and described in *Jones*. The Examiner then states that *Jones* does not explicitly state that the call state information is stored in the memory of the edge device. As noted, the Examiner takes Official Notice that "given the system contains a memory, it would be obvious to store call state information (i.e., duration of call that can be computed from the on/off hook information) in the memory."

Even if the Examiner could provide a reference showing that the network premises gateway 10 of *Jones* could store call state information in its memory, the Applicants submit that combination would still not teach all the claimed elements. This is because the network premises gateway 10 is not an edge device as claimed.

Jones explicitly illustrates the network premises gateway 10 in a customer premise (see figures 1 and 2 of *Jones*). In addition, *Jones* explicitly states that:

"[i]n the preferred embodiment, the network premises gateway 10 connects to PSTN 16 via a PSTN network interface unit (NIU) 18. The PSTN NIU 18 is typically found outside of most homes in the United States. This is the demarcation point between the customer's equipment and the telephone company's equipment." *Jones* at col. 2, lines 26-32.

Contrary to *Jones*, the claimed edge device is a non-customer-premises network element, as noted in the previous Office Action response. The Applicants direct the Examiner to page 7 and 8 of

the present specification along with the arguments presented above. On page 7, on lines 9-13, the present specification states:

The H.323 system 100 includes a virtual distributed gatekeeper 102 and back end servers (BESs) 105. The virtual distributed gatekeeper 102 includes a gate controller (GC) 104 and edge routers (ERs) 106-107. The H.323 system 114 includes a virtual distributed gatekeeper 116 and BESs 117. The virtual distributed gatekeeper 116 includes a GC 118 and ERs 120-121.

The present specification on page 8 further states that "[t]he H.323 system 100 is designed for installation in a cable central office, but it could be used in a telephone central office to replace circuit switched call systems." Thus, call state information contained in the memory of the edge device is contained in a non-customer premises device. As discussed above and in the Office Action response mailed February 4, 2003, storing call state information in a non-customer-premises network element in the path of an H.323 call provides a number of advantages.

For example, having the network element in the path of the H.323 call store the call state information reduces or eliminates the need, expense, hassle and management of encryption algorithms (and their related infrastructure) for maintaining call-state information as is needed when using a customer premises device that has the potential of being compromised and not trusted. Because the network element storing the call-state information is in the path of the call and is generally under the control of one or more service providers, when one of the network elements in the path of the H.323 call fails, the call will terminate, leaving the call-state information under the control of the service provider. This reduces or eliminates (at least as a primary source of the information) elaborate encryption schemes for retrieving call state information stored in end terminals. As apparent to those skilled in the art, other advantages and features of the claimed combination exist as well.

C. Failure to Provide Objective Reason to Combine References

According to M.P.E.P. § 2143, in order to establish the required *prima facie* case of obviousness of a claimed invention by applying a combination of references, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.

In addition, "a statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness without some **objective reason** to combine the teachings of the references." See M.P.E.P. § 2143.01 (bold emphasis added).

The Applicants respectfully submit that the Examiner has not provided a well-reasoned statement showing some suggestion of the desirability of doing what the Applicants have done. Without providing any reference or convincing reasoning, the Examiner, using impermissible hindsight and language similar to the above-quoted language held to be insufficient to establish a *prima facie* case of obviousness, states only "This would improve the system since this provides a means for billing the customer."

The *Jones* reference and the Official Notice do not state anything about billing. Thus, the Applicants submit that the *Jones* and the Official Notice do not provide the suggestion or motivation to combine the references for the purpose of "provid[ing] a means for billing the customer." The Applicants also submit that the Examiner has not provided a well reasoned statement showing that the knowledge generally available to one of ordinary skill in the art at the time of invention would

provide the suggestion or motivation to combine the teachings of *Jones* and the Examiner's Official Notice for the purpose of "provid[ing] a means for billing the customer."

As used by the Examiner, combining the references for the purpose of "improving the system since this provides a means for billing the customer" is as meaningful as saying the combination is obvious because it "makes the system better," which like the cited purpose does not provide a suggestion or motivation to combine the teachings of *Jones* and the Official Notice. Specifically, simply stating that the combination would "improve the system" does not point to combining the supposed elements contained in *Jones* and the supposed elements contained in the Official Notice to obtain the Applicants' invention. Thus, the Examiner has not provided a well-reasoned basis for the combination. Moreover, "improving the system" does not show how the teachings of *Jones* can be combined with teachings of the Official Notice to produce the claimed invention.

At most, "improving the system" provides a reason for applying for a patent in the first place. That is, many patentable inventions are based on the recognition that a specific combination of elements (which appear individually, but not in combination, in the prior art) will result in an improved system. Thus, because of the absence of any evidence of a motivating force, the Applicants submit that the Examiner has failed to meet the initial burden of providing a *prima facie* case of obviousness.

In light of the reasons described above, the Applicants submit that the combination of *Jones* and the Examiner's Official Notice does not disclose the claimed element "an edge device having a first H.323 port and a memory, the memory containing call state information, the call state information including a call state for an H.323 call on the first H.323 port." The Applicants also submit the claimed invention is not disclosed in the cited art, and thus, the remaining un-allowed independent claim 16 is allowable. The Applicant further submit that the remaining un-allowed


dependent claims, which necessarily incorporate the elements of the independent and intervening claims from which they depend, are allowable as well.

4. Conclusion

In view of the foregoing remarks, the Applicants submit that the pending claims are in good and proper form for allowance, and the Applicants respectfully request the Examiner to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would otherwise expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at 312-913-3304.

Respectfully submitted,

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